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EXAMINER
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DURAN, ARTHUR D

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Page 1

Art Unit: 3622



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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 6/16/2005

Application Number: 09/736,032

Filing Date: December 13, 2000

Appellant(s): Savage, James

Daniel A. Thomson  
For Appellant

### **EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/11/05.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The Appellant's statement of the Grounds of Rejection to be Reviewed on Appeal in the brief is correct.

**(7) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3622

**(8) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,740,549 Reilly April, 1998

6,421,650 Goetz July, 2002

6,601,037 Kolls July, 2003

5,755,462 Lupi May, 1998

**(9) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 5, 8, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037).

Claim 1, 2, 4, 5, 8, 11, 15, 19:

Reilly discloses a hand-held electronic device comprising:

a central processing unit;

random accessible memory; a viewing screen;

a motherboard; a modem;

data entry means (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67);

at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device (col 3, lines 5-15).

Art Unit: 3622

Reilly further discloses that the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, color, splash screen displayed in between a prescribing session, and company logo (Fig. 6; col 9, line 65-col 10, line 10; col 2, lines 4-25; col 13, lines 18-21); and, updating means for updating the at least one advertisement (col 3, lines 5-15).

Reilly further discloses updating the advertising via updating the software (col 5, lines 45-60; col 8, lines 5-10).

Reilly further discloses a signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

Reilly further discloses providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20);

Reilly does not explicitly disclose a hand-held device, printing information, or prescription writing means.

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Kolls further discloses audio, video, audio-visual (col 14, lines 50-55; col 33, lines 60-63) and coupon printing (col 17, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, and Kolls advertisement features to Reilly's remote computer with locally stored advertising that gets updated. One would have been motivated to do this because a PDA is a standard type of

Art Unit: 3622

computer, prescription information is standard type of information stored on a computer, and printing information is a standard feature of computers with interfaces so that the user can receive a hard copy of the information viewed.

Also, Reilly discloses that the users computer have memory, a processor, and Internet access (col 6, lines 25-32).

Kolls discloses the utilization of a palm pilot, personal digital assistant (PDA), and other portable devices (col 3, lines 59-67).

Goetz discloses the utilization of a palm pilot, personal digital assistant, and other portable devices (col 5, lines 35-42).

Therefore, it would be obvious to one of ordinary skill in the art that the Reilly device can be of many variations such as a computer, laptop, palm pilot or PDA. One would be motivated to do this to provide convenient access and portable utilization of Reilly's disclosure with the Internet.

Also, Goetz discloses a hand-held device that allows prescription writing (col 5, lines 44-52; col 5, lines 35-40).

Also, Goetz (6,421,650) column 6, lines 8-15 discloses printing:

"Today, this data is typically printed on a sheet (typically 5.5" by 8") that contains common uses, consumption requirements, cautions and possible side effects of the particular medication. Thus the pharmacist component 18 in the system 10 of the present invention, through the pharmacist's PC, reads and write data from the pharmacist's database to the memory device 14 , and will typically supply the data that is conventionally printed on the prescription information sheet to the memory device 14 in addition to medication administration instructions.

Also, Reilly discloses an advertising means comprised of software code for providing the advertising and advertising as part of the advertising providing software:

Art Unit: 3622

“Each advertisement is stored on both the information server and subscriber computers as a C++ data structure that includes (A) an image data array, typically representing a "GIF" format image, as well as (B) a list of static images (such as corporate logos and legends), if any, incorporated into the advertisement, and (C) a Web site address that is used by the World Wide Web connection and viewer procedures 211 to connect the subscriber to the advertiser's specified Web page when the subscriber clicks on the image of the associated advertisement” (col 13, lines 15-25).

Also, Reilly discloses at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device (col 3, lines 5-15).

Also, Reilly discloses advertising stored on the user's local device:

“An information administrator in each workstation establishes communication with the information server from time to time so as to update the information items and advertisements stored in local memory with at least a subset of the information items and advertisements stored by the information server. An information display controller in each workstation displays on the workstation's display device at least a subset of the information items and advertisements stored in local memory when the workstation meets predefined idleness criteria” (col 3, lines 5-15).

Reilly further discloses storing the software on the users device and updating the advertising when updating the software:

“(13) The information database 134 also stores software modules 144 for downloading to subscribers' computers. The information administration management procedures and information viewing procedures in subscribers' computers will need updating and upgrading

Art Unit: 3622

from time to time. The new versions of these software procedures are stored in the information server's information database 134 for downloading into the computers of subscribers at the same time that the information items or advertisements in the subscriber computers' information database 184 is updated. Since numerous types of subscriber computers are supported, the server's information database 134 will typically store a set of updated software modules for each of the supported types of computers (col 5, lines 45-60);

(35) timestamps 217a-217c indicating the time of the last updates to the subscriber computer's locally stored set of news stories, advertisements and administrative files (including scripts, images and software modules); (36) advertising and news item display statistics 218” (col 8, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Reilly's advertisements and software stored on the same local computer and updated at the same time can be associated. One would be motivated to do this to simplify advertising and software upgrading.

Claim 6: Reilly, Goetz, and Kolls disclose the method of claim 4, and Reilly further discloses that the method further comprises the step of:

updating the advertising via the signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

Claims 7, 12, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037) in view of Lupi (5,755,462).



Art Unit: 3622

Claim 7: Reilly, Goetz, and Kolls disclose the method of claim 4. Reilly does not explicitly disclose printing a prescription with the advertising on the prescription.

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising and information that gets updated. One would have been motivated to do this because printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Claim 12, 16: Reilly discloses a method, medium for advertising, the method comprising the steps of:

providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20); and,

providing at least one electronic advertisement on the device, the advertisement being permanently stored on the device (col 3, lines 5-15);  
transmitting information (col 3, lines 5-15).

Reilly further discloses updating the at least one advertisement (col 3, lines 5-15).

Reilly does not explicitly disclose a hand-held device, that the advertisements are banner advertisements or that the transmitted or printing information or that printed information is prescription information.

Art Unit: 3622

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Goetz further discloses advertising information (col 6, lines 64-66).

However, Kolls discloses that banner advertisements can be displayed on a PDA (col 3, lines 63-65; col 33, lines 60-65; col 34, lines 3-5) and that advertisement information and other information can be printed (col 35, lines 60-65).

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, Kolls' banner advertisements, and Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising that gets updated. One would have been motivated to do this because a PDA is a standard type of computer, prescription information is standard type of information stored on a computer, a banner is a standard type of electronic advertisement, and printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Claim 18: Reilly, Goetz, Kolls, and Lupi disclose the computer readable medium of claim 16, wherein providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, comprises:

Art Unit: 3622

providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, the device having a central processing unit, random accessible memory, a mother board, a signal converter, and data entry means (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67).

**(10) Response to Argument**

On page 7, The Appellant states, "The amount of data being downloaded as suggested by Reilly and Kolls would quickly overflow the data storage capability of the hardware of Goetz as it is vastly smaller than the data storage capabilities of the hardware for Reilly and Kolls. In fact, the hardware of Goetz could simply not store all the data that is downloaded to Reilly and Kolls."

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

The Appellant's claims make no mention of any 'data storage capability' minimal or maximal requirement. The Appellant's claims make no mention of any minimal or maximal amount of storage necessary for the hardware. Appellant's claims make no statements as to how much data can be held.

Art Unit: 3622

Additionally, in the MPEP section 716.01(c) under the title “Attorney Arguments Cannot Take the Place of Evidence”, note that objective evidence must be presented to prove inoperability. The Appellant cannot declare the combination of prior art inoperable without objective evidence. The Appellant cannot state that a memory requirement is not met when a) no memory requirement is stated in the Appellant’s claims b) the Appellant has not presented objective evidence of inoperability without certain memory specifications.

Additionally, Goetz discloses that the device of Goetz can store significant amounts of data:

“(19) Physician Component

(20) The physician component 16 is preferably a hand held personal digital assistant device such as a Palm PC or Palm Pilot type device that receives the memory device 14 and reads and writes data from and to the memory device 14.

The physician component 16 is preferably programmed with at least the following basic functions. . .

(22) 2. Contains data specifically tailored for use by the physician, such as a database of diagnoses and common illnesses and correlated potential medications that may be prescribed, and a library of special instructions or treatments to be performed by the patient that the physician may prescribe” (Goetz, col 5, lines 35-50).

A database of diagnoses and common illnesses, associated medications, a library of special medical instruction and treatments and prescriptions constitute a significant amount of data that can be stored on the Goetz device.

On page 13, Appellant states, “Hence, there is nothing desirable about combining the

Art Unit: 3622

downloading of large volumes of data to a PDA.”

However, Goetz discloses that the device of Goetz can store significant amounts of data and that significant amounts of data can be loaded onto the Goetz device:

“(19) Physician Component

(20) The physician component 16 is preferably a hand held personal digital assistant device such as a Palm PC or Palm Pilot type device that receives the memory device 14 and reads and writes data from and to the memory device 14.

The physician component 16 is preferably programmed with at least the following basic functions. . .

(22) 2. Contains data specifically tailored for use by the physician, such as a database of diagnoses and common illnesses and correlated potential medications that may be prescribed, and a library of special instructions or treatments to be performed by the patient that the physician may prescribe” (Goetz, col 5, lines 35-50).

A database of diagnoses and common illnesses, associated medications, a library of special medical instruction and treatments and prescriptions constitute a significant amount of data that can be stored on the Goetz device.,

Also, Reilly discloses that the users computer have memory, a processor, and Internet access (col 6, lines 25-32).

Kolls discloses the utilization of a palm pilot, personal digital assistant (PDA), and other portable devices (col 3, lines 59-67).

Goetz discloses the utilization of a palm pilot, personal digital assistant, and other portable devices (col 5, lines 35-42).

Art Unit: 3622

Therefore, it would be obvious to one of ordinary skill in the art that the Reilly device can be of many variations such as a computer, laptop, palm pilot or PDA. One would be motivated to do this to provide convenient access and portable utilization of Reilly's disclosure with the Internet.

On page 13, Appellant states that the combination of the prior art does not render obvious the features, "the at least one advertisement being permanently stored on the device".

Examiner notes that Appellant's independent claim 1 states, "updating means for updating the at least one advertisement".

Hence, because the advertising is updated, the advertisement can be changed.

Examiner notes that because the claim states that the advertisement is permanently stored on the device and that the advertisement can be changed that the claim was interpreted to mean that the advertisement is stored in non-volatile memory. That is, the claim was interpreted to mean that the advertisement remains on the device even when the device is turned off as opposed to a temporary stored advertisement that does not remain on the device or would disappear if the device were shut off.

Reilly discloses that advertisements are permanently stored on the user device and that the advertisements stored on the user device can be updated:

"An information administrator in each workstation establishes communication with the information server from time to time so as to update the information items and advertisements stored in local memory with at least a subset of the information items and advertisements stored by the information server. An information display controller in each workstation displays on

Art Unit: 3622

the workstation's display device at least a subset of the information items and advertisements stored in local memory when the workstation meets predefined idleness criteria" (col 3, lines 5-15).

Hence, Reilly discloses that advertisements are locally stored on the user's machine, that the advertisements can be updated by the central controller (information server), that the advertisements are always on the user machines, and that the user is not presented with any options of removing or deleting or preventing or taking away any advertising.

Hence, Reilly discloses at least one advertisement being permanently stored on the user device.

On page 7 of the Appellant's Appeal Brief, Appellant states, "However, there is no motivation in the references cited to make such a combination as Goetz makes no reference to advertising in any form and neither Reilly nor Kolls discusses a prescription writing device having at least one advertisement permanently stored in the software."

However, Goetz does disclose advertising:

"(29) The memory device 14 will contain at least the following data about the patient: 1. Patient Identification Information . . . 7. Prescription data. . . 8. Other information 8.1. Advertising messages for product sponsors" (col 6, lines 29-67).

And, Examiner notes that, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 3622

Also, Examiner notes that it is the combination of the prior art that renders the Appellant's claims obvious. Hence, all of Appellant's features will not be found present in any one piece of the prior art. Rather, it is the combination of Reilly, Gotez, and Kolls that renders the features of the Appellant's claims obvious.

On page 7, Appellant states, "Nowhere in the references do the patents teach, mention, or allude to permanent storage of the advertisements as part of the software code of a prescription writing device."

Examiner notes that independent claims 1, 2, 8, 12, 16, 18 make no provision that the advertising be permanently stored on the device as part of the software code. Only Appellant's dependent claim 5 states that the advertising be permanently stored on the device as part of the software code. In fact none of the Appellant's independent or dependent claims, except for claim 5, make any statement that the advertising be part of the software code. Only Appellant's dependent claim 5 makes any mention of the advertising being part of the software code.

Examiner notes that claim 5 is dependent upon claim 4 which is dependent upon claim 2. Claim 2 discloses providing software for operating the device and providing means for advertising. Claim 5, dependent upon Claim 2, states that the advertising means comprises a software code and advertising that is part of the software code. Examiner notes that this advertising means as claimed comprises software code which is distinct from the software for operating device the as stated in the second step of Claim 2. Examiner further notes that the software codes stored on the device are interpreted as being the display and formatting codes for that advertisement. Thus, the advertising means is comprised of software code for providing the



Art Unit: 3622

advertising in the proper format and the advertising content itself as part of the advertising providing software.

Reilly discloses an advertising means comprised of software code for providing the advertising and advertising as part of the advertising providing software:

“Each advertisement is stored on both the information server and subscriber computers as a C++ data structure that includes (A) an image data array, typically representing a "GIF" format image, as well as (B) a list of static images (such as corporate logos and legends), if any, incorporated into the advertisement, and (C) a Web site address that is used by the World Wide Web connection and viewer procedures 211 to connect the subscriber to the advertiser's specified Web page when the subscriber clicks on the image of the associated advertisement” (col 13, lines 15-25).

Also, Reilly discloses at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device (col 3, lines 5-15).

Also, Reilly discloses advertising stored on the user's local device:

“An information administrator in each workstation establishes communication with the information server from time to time so as to update the information items and advertisements stored in local memory with at least a subset of the information items and advertisements stored by the information server. An information display controller in each workstation displays on the workstation's display device at least a subset of the information items and advertisements stored in local memory when the workstation meets predefined idleness criteria” (col 3, lines 5-15).

Art Unit: 3622

Reilly further discloses storing the software on the users device and updating the advertising when updating the software:

“(13) The information database 134 also stores software modules 144 for downloading to subscribers' computers. The information administration management procedures and information viewing procedures in subscribers' computers will need updating and upgrading from time to time. The new versions of these software procedures are stored in the information server's information database 134 for downloading into the computers of subscribers at the same time that the information items or advertisements in the subscriber computers' information database 184 is updated. Since numerous types of subscriber computers are supported, the server's information database 134 will typically store a set of updated software modules for each of the supported types of computers (col 5, lines 45-60);

(35) timestamps 217a-217c indicating the time of the last updates to the subscriber computer's locally stored set of news stories, advertisements and administrative files (including scripts, images and software modules); (36) advertising and news item display statistics 218” (col 8, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Reilly's advertisements and software stored on the same local computer and updated at the same time can be associated. One would be motivated to do this to simplify advertising and software upgrading.

Also, Examiner notes that Schena (5,946,646) and Ebisawa (5,946,664) disclose that advertisements can be part of the software code:

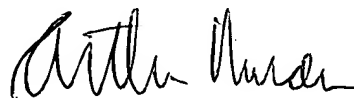
Art Unit: 3622

“(9) U.S. Pat. No. 5,105,184 entitled Methods For Displaying An Integrating Commercial Advertisements For Computer Software discloses a system directed to adding commercial advertisements for different screen types. In this patent, the advertisements are hard coded into the software” (Schena; col 1, lines 55-60); and

“Further, instead of downloading new advertisements, plural advertisements may be prestored with the game program and only advertisement selection codes are downloaded to update the advertisements that are displayed when the game program is executed” (Ebisawa, Abstract).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Arthur Duran  
Patent Examiner

August 15, 2005

Conferees:

Eric Stamber



James Myhre

